

Attorney Docket No.: BLD920010034US2

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In Re PATENT APPLICATION Of:

Carl M. Dennison et al.

Appln. No.: 10/065,527

Filed: October 25, 2002

For: VISUAL JOB TICKETING USING  
A DOCUMENT VIEWING  
APPLICATION

Examiner: Peter K. HUNTSINGER

Art Unit: 2624

Mail Stop **APPEAL BRIEF – PATENTS**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**REPLY BRIEF UNDER 37 CFR §41.41**

**PROCEDURAL**

The Examiner's Answer (hereinafter "Answer"), mailed August 29, 2007, asserts in a section labeled "GROUNDS OF REJECTION NOT ON REVIEW" that the final rejection of "[c]laims 4 and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement" has "not been withdrawn by the examiner, but they are not under review on appeal because they have not been presented for review in the appellant's brief."

To the contrary however, the Advisory action (hereinafter "Advisory"), mailed June 26, 2006, clearly indicates on page 2, #5, that the Amendment After Final (hereinafter "AAF"), mailed April 10, 2006, overcame that rejection. Furthermore, the Advisory also clearly indicates on page 2, #7, that the AAF would be entered upon

appeal. A Notice of Appeal was filed May 9, 2006 and an Appeal Brief was filed July 26, 2006. Therefore, the final rejection of “[c]laims 4 and 12 … under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement” has “been withdrawn by the examiner, [and so,] they are not under review on appeal … .”

### **REJECTION UNDER 35 U.S.C. §102(e)**

“A claim is anticipated only if each and every element **as set forth in the claim** is found, either expressly or inherently described, in a single prior art reference.<sup>1</sup>” “The identical invention must be shown in as complete detail as is contained in the … claim.<sup>2</sup>” During patent examination, the pending claims must be given the broadest reasonable interpretation “**consistent with** the interpretation that **those skilled in the art** would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).<sup>3</sup>”

The Answer makes note of the fact “that the specification lacks a clear definition of the term document.<sup>4</sup>” Thus, the Answer turns to www.dictionary.com, and asserts that “the definition **within the art** [is that] a document is a writing that contains information … .<sup>5</sup>” So, relying upon this definition, the Answer concludes that the “print preview image 68 of Livingston (Fig. 3A, col. 5, lines 38-39) clearly demonstrates a writing (has text) that contains information (corresponds to a print job, col. 5, lines 43-44).<sup>6</sup>”

Without providing any substantive support for the conclusion, the Answer concludes that the “Appellant’s argument that the definition of a document [also found at www.dictionary.com] is ‘d. Computer Science. A piece of work created with an application, as by a word processor. e. Computer Science. A computer file that is not an

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<sup>1</sup> *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added).

<sup>2</sup> *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

<sup>3</sup> MPEP, §2111, (emphasis added).

<sup>4</sup> Page 10, second full paragraph.

<sup>5</sup> Id, (emphasis added).

<sup>6</sup> Id, (emphasis added).

executable file and contains data for use by applications’ is unreasonable [sic] narrow.<sup>7</sup>” What makes the field of computer science unreasonably narrow? It seems appropriate to the appellants.

Without specifying any field, the Answer continues, asserting that a “printed document is clearly a recognized term to someone of ordinary skill within the art but this would not fall under the limited definition used by the Appellant.” If not computer science, which art? If a definition within computer science is a limited definition, which broader art that includes computer science is more appropriate and why?

That computer science is not the proper field and what one of ordinary skill in computer science would understand a document cannot be refuted merely by a conclusory statement that the definition “is unreasonable [sic] narrow.<sup>8</sup>” The Appellants have shown by independent evidence, evidence introduced by the Examiner in the Office actions, that one of ordinary skill in computer science would understand a document to be “d. Computer Science. A piece of work created with an application, as by a word processor. e. Computer Science. A computer file that is not an executable file and contains data for use by applications.<sup>9</sup>” Therefore, it is incumbent upon the Examiner to show, first what broader art field is more appropriate; and second, that a person of ordinary skill in that broader art field would consider the “print preview image 68 of Livingston … a writing” within that broader art. No such showing has been made

Further, the Answer relies upon the fact that “Appellant’s specification uses the term ‘printed output document’ (page 4, paragraph 14) [to show that] one of ordinary skill in the art would recognize the broader definition of document as meaning writing that contains information.” However, “printed output document” is taken totally out of context.

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<sup>7</sup> Page 10, third full paragraph.

<sup>8</sup> *Id.*

<sup>9</sup> *Supra.*

When executing with a document viewing application program as described above, the plug-ins of the present invention insert visual feedback directly into the source document (for example, adding a dog-ear corner to the upper right page corner to show duplex printing, see FIG. 2), so any user interactions in the source document apply to the visual feedback as well. . . . When the document is to be saved or printed, the plug-ins search each page for visual cue objects and remove them, so that the saved or printed document does not include the cues. For example, dog-ear corners are very useful when editing the job ticket in the application, but are not desirable in the printed output document. The job ticket parameters represented by the visual cues are stored or printed via the job ticket instead.<sup>10</sup>

Furthermore, reliance on printed output document only in the present specification is somewhat selective. Livingston specifically recites “displaying a **print preview image** of a selected page **in a document** in the first sub-portion.<sup>11</sup>” That the Livingston document is to be printed does not make the “print preview image 68 of Livingston” a document; nor does it lead one of ordinary skill in the computer sciences to take it to be so.

The Answer asserts that in Livingston “when the user deselects ‘Staple this Job Using’, the staples displayed on print preview image 68 will be removed, S9 of Fig. 4, col. 6, lines 1-20, settings are applied and print preview is updated,” teaches “inserting into the original document a plurality of visual cue objects corresponding to print job ticketing parameters, thereby creating an amended document (staples 69 of Fig. 3A, col. 5, lines 38-39), and removing from the amended document, for specific operations to be performed on the amended document, at least one of the plurality of visual cue objects (staples 69 of Fig. 3A, col. 5, lines 38-39)<sup>12</sup>.” However, it is clear from Livingston that the printer options that define that print preview image, if stored, are stored as “Quick Sets<sup>13</sup>” separate from the documents, for quick recall and application to a document (any

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<sup>10</sup> Application, paragraph 0014 (emphasis added).

<sup>11</sup> Col. 1, lines 51 – 52 (emphasis added).

<sup>12</sup> Page 11, first full paragraph.

<sup>13</sup> Figures 3A – B.

document) being printed.<sup>14</sup> They are not stored in the document and so, they are not removed from the document.

Manipulating images/icons overlaid on a screen does not change the underlying image and certainly does not imbed those images/icons or corresponding functions into the document from which the page that underlies the image is selected. Certainly, there is nothing in Livingston to teach or suggest embedding selected printer options, such as are stored in the quick sets, into the document that includes the displayed page.

Therefore, Livingston does not teach the present invention or an equivalent thereof, and so, does not anticipate the present invention, under 35 U.S.C. §102(e), as recited in any of claims 1, 3 – 5, 9 and 11 – 13. Since Livingston does not anticipate the present invention, the appellants respectfully request that the board reverse the rejection of claims 1, 3 – 5, 9 and 11 – 13.

#### **REJECTION UNDER 35 U.S.C. §103(a)**

The Answer only briefly summarizes the applicants arguments with regard to Moore; asserting that “Appellant alleged that Moore ‘124 is inconsistent with the teaching of Livingston ‘454.” So, reciting MPEP §2145 III, in part, for authority, the Answer asserts that because the Livingston print preview image 68 is, allegedly, the claimed amended document, it combines with “Moore ‘124 [to teach] automatically saving a document when printing (col. 7, lines 12-18). Whether or not the amended document of Livingston ‘454 is the identical document of Moore ‘124, it is apparent that images can clearly be saved.” “However, the claimed combination cannot **change the**

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<sup>14</sup> See also, col. 6, lines 38 – 43 (“Displaying only the controls for the currently selected feature in the second sub portion 58 allows those controls to be viewed without distracting the user with controls for other features.”).

**principle of operation** of the primary reference or render the reference inoperable for its intended purpose.<sup>15</sup>”

First, combining the specific teachings of both Moore<sup>16</sup> and Livingston without changing the principle of operation of Livingston, results in saving a document, not the image that is displayed. Clearly Moore treats a document as described above for the computer sciences art, not a print preview image, which is what the Answer relies upon. Second, saving the Livingston document that is the source of the page displayed in the print preview image 68 does not embed the options (e.g., from a saved set) in or, remove the options from, the document. Therefore, the combination of Moore with Livingston does not suggest the above noted elements missing from Livingston, much less result in the present invention. Therefore also, the combination of Livingston and Moore is not *prima facie* obvious under 35 U.S.C. §103(a) for finally rejected claims 2 or 10 or, for any other claims depending from claims 1, 3 – 5, 9 and 11 – 13.

## CONCLUSION

Therefore, as previously noted, Livingston does not literally anticipate the present invention because the claims clearly recite “creating an amended document,” not an amended GUI image and, thereafter, operating on the amended document; and Livingston fails to teach anything that could be considered by one of ordinary skill in computer science to be “an amended document” (as recited by claims 1 and 9). Nor does “at least one page of the document . . . is being previewed in the print preview image 68”<sup>17</sup> teach equivalent structure or steps to anticipate the present invention; nor would one of ordinary skill in computer science consider the GUI image a document, given “broadest reasonable interpretation consistent with the specification.”<sup>18</sup> Neither do any of the cited

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<sup>15</sup> MPEP §2145 III (emphasis added).

<sup>16</sup> Col. 7, lines 12 – 18.

<sup>17</sup> *Supra*.

<sup>18</sup> MPEP, §2111.

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references suggest or provide anything to cure these shortcomings to result in claims 1 and 9, much less claims depending therefrom.

Therefore, anticipation has not been shown under 35 U.S.C. §102(e) for any of claims 1, 3 – 5, 9 and 11 – 13; and, obviousness has not been shown under 35 U.S.C. §103(a) for any of claims 2, 6 – 8, 10 or 14 – 20. The Appellants respectfully request that the board reverse the rejection of claims 1, 3 – 5, 9 and 11 – 13 under 35 U.S.C. §102(e) and claims 2, 6 – 8, 10 or 14 – 20 under 35 U.S.C. §103(a).

Please charge any deficiencies in fees and credit any overpayment of fees to Deposit Account No. 50-3669 and advise us accordingly.

Respectfully Submitted,

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(Date)

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